

REMARKS

Claims 1-30 are pending.

In the Office Action dated September 25, 2010, claims 1-12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 1-4 and 12-17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez (U.S. Patent Publication No. 2002/0194138) in view of Putta (U.S. Patent Publication No. 2001/0032192) and Kolling (U.S. Patent No. 5,963,925); claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Putta and Kolling, and further in view of Ensel (U.S. Patent No. 6,493,685); claims 7, 8, 10, and 26-29 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Putta and Kolling, and further in view of Byrne (U.S. Patent Publication No. 2003/0229590); claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Putta and Kolling, and further in view of Byrne and Jamison (U.S. Patent Publication No. 2003/0191711); claim 11 was rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Putta and Kolling, and further in view of Crea (U.S. Patent Publication No. 2004/0210521); claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Putta, Kolling, and Mersky (U.S. Patent No. 6,119,106); claims 20 and 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez in view of Kolling and Cook (U.S. Patent No. 6,675,153); claims 21 and 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Kolling and Cook, and further in view of Byrne; claims 23 and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Cook and Kolling, and further in view of Mersky; claim 30 was rejected under 35 U.S.C. § 103(a) as unpatentable over Dominguez, Putta, Kolling, Mersky, and further in view of Byrne.

REJECTION UNDER 35 U.S.C. § 112, ¶ 2

Applicant respectfully disagrees that use of the phrase “if the payment is authorized” renders claim 1 unclear. A person of ordinary skill in the art would clearly understand that a system can be configured to perform a particular action based on a condition occurring, which in the case of claim 1 is when the payment is authorized.

Such conditional performance of a task does not render the claim indefinite – rather, it is clear that the “sending” clause of claim 1 is a positive step that occurs when a particular condition is satisfied.

A person of ordinary skill in the art would understand that any system involves configuring the system to perform different tasks under different conditions. Therefore, it is respectfully submitted that claim 1 is not rendered unclear based on the presence of the phrase “if the payment is authorized.”

It is noted that claim 1 has been amended to improve its form by replacing “if the payment is authorized” with “in response to determining that the payment is authorized.”

In view of the foregoing, it is respectfully submitted that the § 112 rejection be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

Claim 1 has been amended to clarify that the payment is by the consumer to the biller for a bill provided by the biller to the consumer. Support for this amendment can be found at least on page 6, lines 15-17, of the present application as filed.

It is respectfully submitted that claim 1 is non-obvious over Dominguez, Putta, and Kolling.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as held by the U.S. Supreme Court, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

The Office Action conceded that Dominguez and Putta fail to disclose the following elements of claim 1:

- wherein the authorization information (transmitted to a website of a biller) is formatted to appear as originating from the biller and in a predefined format specified by the biller; and

- wherein the electronic notification (sent from the authorization system directly to the consumer that the payment has been authorized) is formatted to appear as originating from the biller and in a predefined format specified by the biller. 06/25/2010 Office Action at 6.

However, the Office Action cited Kolling as purportedly disclosing the claimed subject matter missing from Dominguez and Putta. *Id.*

Kolling describes an electronic statement presentment system to replace paper statements and invoices from a biller with electronic statements or invoices. Kolling, Abstract; 4:15-29. The electronic statements have the same “look and feel” as paper statements. *Id.*, 4:20-22. As best seen in Fig. 3 of Kolling, the electronic statement (224) is sent from a statement generation workstation 222 through a consumer financial institution 130 to a consumer 140.

The citation of Kolling against the subject matter of claim 1 conceded to be missing from Diminguez and Putta is defective for at least the following reasons. First, sending an electronic statement 224 in place of a paper statement is completely unrelated to the “transmitting” and “sending” clauses of claim 1. In claim 1, **authorization information** is transmitted by at least one computer through a network to a website of a biller, where the **authorization information** includes whether to authorize the payment or refuse authorization of the payment, and where the **authorization information** is formatted to appear as originating from the biller and in a predefined format specified by the biller. Sending the electronic statement 224 to the consumer 140 as shown in Fig. 3 of Kolling is tantamount to sending a bill to a consumer, and clearly does not constitute sending authorization information including whether to authorize the payment or refuse authorization of the payment, and also clearly does not provide any hint of transmitting authorization information **to a website of the biller**.

Moreover, note that claim 1 further recites, in addition to transmission of the authorization information to the website of the biller, sending an electronic notification directly to the consumer that the payment has been authorized, in response to determining that the payment is authorized, where the electronic notification is formatted to appear as originating from the biller and in a predefined format specified by the biller. Thus, according to claim 1, **authorization information** is sent to **both** the website of the **biller** and to the **consumer**. As noted on page 9, last paragraph, of the present application, the

benefit of performing such transmission or sending in accordance with some embodiments is that the customer is able to receive at least one of two notices even if one is lost in transit.

In contrast, according to Kolling, an electronic statement is sent from a statement generation workstation 222 to a consumer through a consumer financial institution—the concept of transmitting authorization information to **both** the website of the biller as well as directly to the consumer clearly does not exist in Kolling.

It appears that the Office Action recognized that Kolling does not relate to sending of authorization information, since the Office Action on page 6 notes that “Dominguez teaches a method that includes transmitting authorization information and Putta teaches methods for transmitting notifications.” 06/25/2010 Office Action at 6. It is noted that the authorization information described in Dominguez is in the form of an authorization response provided by an issuer financial institution that processes an authorization request. *See* Dominguez, ¶¶ [0066]-[0068]. As explained in ¶ [0035] of Dominguez, such financial institution can be a card issuer, such as a Visa card issuer (note that the assignee of Dominguez is Visa International Service Association). As depicted in Fig. 4 of Dominguez, a card holder visits a merchant site (step 1 in Fig. 4 of Dominguez), the merchant sends an authorization message to the card issuer (step 4 in Fig. 4), and the issuer authorizes the transaction (step 5). Thus, the authorization response noted in ¶ [0068] of Dominguez is an authorization response provided by a financial institution such as a credit card bank. It is noted that the financial institution would typically have to interact with a large number of merchants. Therefore, according to Dominguez, the authorization response sent from the financial institution to the merchants would have a format specified by the financial institution, not by the merchant. In a context of Dominguez, the merchant would be the biller—therefore, any authorization information sent from the financial institution to the merchant (biller) would not have a format that is formatted to appear as originating from the merchant (biller).

In fact, since the authorization response is sent to the merchant for the benefit of the merchant to authorize a transaction, there would be no reason whatsoever to make such authorization response to appear as originating from the merchant (biller).

Putta relates to a method for issuing a secondary programmable account number (SPAN) to a customer such that the customer can use the SPAN to pay for purchase from a merchant. Putta, Abstract; ¶ [0054]. There is absolutely no hint given in Putta of transmitting authorization information (formatted to appear as originating from the biller) to a website of a biller, in addition to sending an electronic notification directly to the consumer that payment has been authorized in response to determining that the payment is authorized, where the electronic notification is also formatted to appear as originating from the biller.

In view of the foregoing, it is clear that even if Dominguez, Putta, and Kolling were to be hypothetically combined, the hypothetical combination of references would not have led to the subject matter of claim 1. Moreover, in view of the significant differences between the claimed subject matter and the teachings of Dominguez, Putta, and Kolling, no reason existed that would have prompted a person of ordinary skill in the art to combine the teachings of the references to achieve the subject matter of claim 1.

In view of the significant differences between the claimed subject matter and the teachings of the references, it is clear that a person of ordinary skill in the art would not have recognized that substituting the teachings of Kolling into the systems of Dominguez and Putta constitutes a mere simple substitution of one known element for another, where the results of the substitution would be predictable. Specifically, it is clear that Kolling relates to sending of an electronic statement (in place of a paper statement), which has absolutely nothing to do with sending authorization information, as claimed.

Moreover, the Office Action erred in arguing that a person of ordinary skill in the art would have been prompted to vary the teachings of Dominguez and Putta to incorporate the subject matter of Kolling, based on the allegation that the variations would have been predictable to such a person of ordinary skill in the art. It is clear that the sending of an electronic statement in place of a paper statement, as taught by Kolling, has nothing to do with sending authorization information as claimed.

Therefore, it is clear that the obviousness rejection of claim 1 is erroneous.

Independent claims 13-16 are allowable over Dominguez, Putta, and Kolling for similar reasons as claim 1.

The obviousness rejection of independent claims 18 and 19 over Dominguez, Putta, Kolling, and Mersky is also erroneous. It is noted that in the rejection of claims 18 and 19, the Office Action used the same defective argument in arguing that Kolling discloses the subject matter of these claims conceded to be missing from Dominguez and Putta. 06/25/2010 Office Action at 21-22. Mersky was cited by the Office Action regarding one or more billing personnel responsible for bills, and reporting information identifying billing personnel to the biller. However, Mersky provides no hint of the subject matter of claims 18 and 19 conceded to be missing from Dominguez and Putta, and incorrectly argued by the Office Action to be present in Kolling.

In view of the foregoing, it is clear that the obviousness rejection of claims 18 and 19 is erroneous.

The obviousness rejection of independent claim 20 over Dominguez in view of Kolling and Cook is also erroneous. With respect to claim 20, the Office Action conceded that Dominguez and Cook fail to disclose that the authorization information communicated to the biller's web server is formatted to appear as originating from the biller and in a predefined format specified by the biller, and that the e-mail containing authorization information sent to the payor's computer is formatted in a predefined format specified by the biller such that the e-mail appears to be generated by the biller. 06/25/2010 Office Action at 30. Instead, the Office Action cited Kolling as purportedly disclosing the foregoing elements of claim 20. As explained above in connection with claim 1, Kolling clearly does not provide any teaching or hint of the subject matter of claim 20 missing from Dominguez and Cook.

Therefore, the obviousness rejection of claim 20 is also clearly erroneous.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the allowability of base claims, the obviousness rejections of dependent claims have been overcome.

In view of the foregoing, allowance of all claims is respectfully requested.

Appl. No.: 10/730,228
Reply to Office Action of June 25, 2010

The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (200901561-1).

Respectfully submitted,

Date: September 27, 2010

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